

REMARKS/ARGUMENTS

Claims 1-17 are pending. By this Amendment, the specification and claims 13 and 14 are amended. Support for the amendments to claims 13 and 14 can be found, for example, in original claims 13 and 14. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Objection to the Specification

The Office Action objects to the specification as including informalities. By this Amendment, the specification is amended to obviate the objection. Accordingly, reconsideration and withdrawal of the objection are respectfully requested.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 11, 13, 14 and 17 as indefinite under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse the rejection.

With respect to claim 11, the Office Action asserts that the phrase "substantially free" renders the claim indefinite. *See* Office Action, page 4. Applicants submit that one of ordinary skill in the art could readily discern the meaning of the term "substantially free." *See* MPEP §2173.05(b) (discussion of definiteness of term "substantially").

With respect to claims 13 and 14, by this Amendment, claims 13 and 14 are amended to obviate the objection.

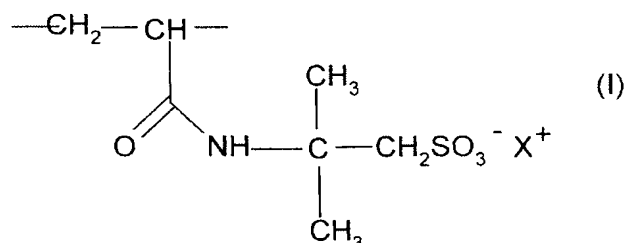
With respect to claim 17, the Office Action asserts that Applicants must submit units for the recited range of weight-average molecular weights. *See* Office Action, page 4. Applicants submit that recited weight-average molecular weight need not be accompanied by units.

For the foregoing reasons, claims 11, 13, 14 and 17 are definite. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

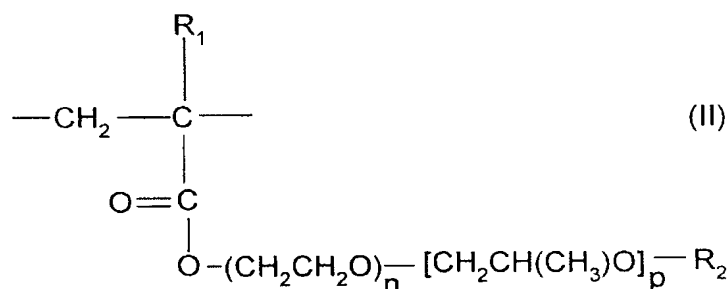
Rejection Under 35 U.S.C. §102

The Office Action rejects claims 1-7, 11, 12, 15 and 16 under 35 U.S.C. §102(b) over EP 1 069 142 to Morschhauser et al. ("Morschhauser").\* Applicants respectfully traverse the rejection.

Claim 1 recites "[a] composition suitable for topical application comprising an oily phase dispersed in an aqueous phase, at least one wax, and at least one non-crosslinked amphiphilic polymer, said polymer comprising from: (a) 80 mol% to 99 mol% of 2-acrylamido-2-methylpropanesulphonic acid (AMPS) units of formula (I) below:



in which X<sup>+</sup> is a proton, an alkali metal cation, an alkaline-earth metal cation, an ammonium ion or an organic cation; and (b) 1 mol% to 20 mol% of units of formula (II) below:



in which n and p, independently of each other, denote an integer ranging from 0 to 24, with the proviso that n + p is less than 25; R<sub>1</sub> denotes a hydrogen atom or a linear or branched

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\* Discussion of Morschhauser is made with reference to U.S. Patent No. 6,645,476, which the Office Action indicates is an English-language equivalent.

alkyl radical containing from 1 to 6 carbon atoms, and R2 denotes a linear or branched alkyl radical containing from 6 to 30 carbon atoms" (emphasis added). Morschhauser does not disclose or suggest such a composition.

As correctly pointed out in the Office Action, Morschhauser generally discloses cosmetic compositions including a polymer of AMPS and methacrylic acid esters. *See, e.g., Morschhauser*, column 11, Example 2. Morschhauser further indicates that the disclosed compositions may include waxes. *See, e.g., Morschhauser*, column 9, lines 27 to 32. However, Morschhauser does not disclose a single embodiment including all of the features of claim 1. For example, Morschhauser does not indicate that the disclosed polymers should or should not be crosslinked. While Morschhauser discloses a single embodiment including a wax as an additional ingredient, the composition in that embodiment is a water-in-oil emulsion (*see Morschhauser*, column 20, lines 27 to 50) – not an oil-in-water emulsion as required by claim 1. Morschhauser discloses two embodiments that are oil-in-water emulsions, but the compositions include an AMPS polymer that falls outside the scope of claim 1 (the AMPS polymer contains 25 oxyethylene groups) and do not include waxes as required by claim 1 (*see Morschhauser*, column 19, line 20 to column 20, line 8) – again Morschhauser fails to disclose a composition falling within the scope of claim 1. That is, Morschhauser does not disclose the particular combination of features recited in claim 1, and there is nothing in Morschhauser that would have led a skilled artisan to select the particular combination of features recited in claim 1.

For the reasons discussed above, a *prima facie* case of obviousness has not been made. However, even if a *prima facie* case were made, such case is rebutted by the results shown in the present specification and the Declaration Under 37 C.F.R. §1.132 ("Declaration") attached hereto – "[a] *prima facie* case of obviousness ... is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior

properties." *See* MPEP §2144.09 (citing *In re Papesch*, 315 F.2d 381 (C.C.P.A. 1963)). The Examples and Comparative Examples of the present specification demonstrate that oil-in-water emulsions that do not include waxes, but that are otherwise identical to compositions as recited in claim 1, have inferior stability. *See, e.g.*, present specification, page 36, line 23 to page 37, line 2. The Examples and Comparative Examples of the present specification, along with the further Comparative Example described in the Declaration, further demonstrate that, in oil-in-water emulsions that are otherwise identical, employing an AMPS copolymer having fewer than 25 oxyethylene groups provides improved stability. *See, e.g.*, present specification, page 37, line 25 to page 38, line 6; Declaration, paragraph 9. These results are objective evidence of the improvements of the composition of claim 1 over known compositions as in Morshhauser, and thus these results rebut any suggestion that it would have been obvious to modify the compositions of Morschhauser as proposed in the Office Action.

The present inventors discovered that it is possible to obtain stable oil-in-water emulsions containing waxes, that have good cosmetic properties and that may advantageously be free of emulsifying surfactant, by employing, in combination, particular non-crosslinked polymers including: a) a specific quantity of AMPS units, b) a defined proportion of side chains and c) less than 25 oxyethylene groups. *See, e.g.*, present specification, page 4, lines 11 to 19. Morchhauser does not disclose or suggest the particular combination of features recited in claim 1, or recognize the benefits stemming therefrom.

For the reasons discussed above, Morschhauser fails to disclose or suggest a composition that is an oil-in-water emulsion, includes a wax, and includes an AMPS polymer having less than 25 oxyethylene groups. Accordingly, Morschhauser fails to disclose or suggest each and every feature of claim 1.

As explained, claim 1 is not anticipated by Morschhauser. Claims 2-7, 11, 12, 15 and 16 depend from claim 1 and, thus, also are not anticipated by Morschhauser. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §103

A. Morschhauser

The Office Action rejects claims 1-17 under 35 U.S.C. §103(a) over Morschhauser. Applicants respectfully traverse the rejection.

For the reasons discussed above, Morschhauser fails to disclose or suggest each and every feature of claim 1 and, thus, would not have rendered obvious claim 1. Claims 2-17 depend from claim 1 and, thus, also would not have been rendered obvious by Morschhauser. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Morschhauser and Lennon

The Office Action rejects claims 1-17 under 35 U.S.C. §103(a) over Morschhauser in view of U.S. Patent Application Publication No. US 2003/0157047 to Lennon et al. ("Lennon"). Applicants respectfully traverse the rejection.

Lennon cannot be applied against the present claims in an obviousness rejection pursuant to 35 U.S.C. §103(c). Lennon is only potentially available as prior art against the present application under 35 U.S.C. §102(e), (f) or (g). Lennon is not available as prior art under 35 U.S.C. §102(a) because Lennon was published on August 21, 2003, while the present application is entitled to a priority filing date of April 11, 2003 under 35 U.S.C. §119 (Applicants' priority claim is acknowledged in the Office Action, and a translation of French Patent Application No. 0304577 is attached hereto). Lennon is not available as prior art under 35 U.S.C. §102(b) because the August 21, 2003 publication date of April 11, 2003

precedes the March 31, 2004 filing date of the present application by less than one year. The presently claimed invention and the subject matter disclosed in Lennon were owned and/or subject to an obligation of assignment to L'Oreal at the time the presently claimed invention was made. *See* Assignments relating to Lennon at Reel 013811, Frame 0228; *see* Assignments relating to present application at Reel 015685, Frame 0026.

As Lennon is only potentially available as prior art against the present application under 35 U.S.C. §102(e), (f) or (g), and the subject matter disclosed in Lennon and the presently claimed invention were owned and/or subject to an obligation of assignment to the same entity at the time the presently claimed invention was made, Lennon cannot form the basis of an obviousness rejection pursuant to 35 U.S.C. §103(c).

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

C. Lennon

The Office Action rejects claims 1-17 under 35 U.S.C. §103(a) over Lennon. Applicants respectfully traverse the rejection.

For the reasons discussed above, Lennon cannot be applied against the present claims in an obviousness rejection pursuant to 35 U.S.C. §103(c). Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Double Patenting

A. 674 Patent

The Office Action rejects claims 1-17 under the judicially created doctrine of obviousness-type double patenting over claims 1-5, 22-27 and 29-49 of U.S. Patent No. 6,905,674. As conceded in the Office Action, the claims of the 674 patent do not require a

wax. *See* Office Action, page 5. Accordingly, for the reasons discussed above with respect to Morschhauser, the claims of the 674 patent do not render obvious claim 1 of the present application. Claims 2-17 of the present application depend from claim of the present application and, thus, also are not obvious over the claims of the 674 patent. Reconsideration and withdrawal of the rejection are respectfully requested.

B. 013 Application

The Office Action provisionally rejects claims 1-10 and 12-17 under the judicially created doctrine of obviousness-type double patenting over claims 1-19 of U.S. Patent Application No. 10/813,013. As conceded in the Office Action, the claims of the 013 application do not require a wax. *See* Office Action, page 7. Accordingly, for the reasons discussed above with respect to Morschhauser, the claims of the 013 application do not render obvious claim 1 of the present application. Claims 2-17 of the present application depend from claim of the present application and, thus, also are not obvious over the claims of the 013 application. Reconsideration and withdrawal of the rejection are respectfully requested.

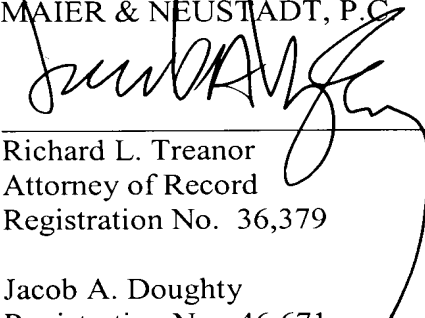
Application No. 10/813,098  
Reply to Office Action of October 5, 2007

Conclusion

For the foregoing reasons, Applicants submit that claims 1-17 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

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Attachment:

Substitute Abstract

Declaration Under 37 C.F.R. §1.132

English-language Translation of French Patent Application No. 0304577